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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/682,229	08/08/2001	Ruth E. Rosenholtz	108762	9873

27074 7590 08/11/2005

OLIFF & BERRIDGE, PLC.
P.O. BOX 19928
ALEXANDRIA, VA 22320

EXAMINER

STORK, KYLE R

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/682,229

Applicant(s)

ROSENHOLTZ ET AL.

Examiner

Kyle R. Stork

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-22, 25-28 and 30-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-22, 25-28 and 30-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This final office action is in response to the request for continued examination filed 10 June 2005.
2. Claims 1-3, 6-22, 25-28, and 30-40 are pending. Claims 1, 16, 20, 21, 28, and 38 are independent claims.

Oath/Declaration

3. The declaration filed on 10 June 2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Smith reference.

Applicant attempts to establish prior invention by a showing of reduction to practice prior to the date of the Smith reference.

The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show.

A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131. (MPEP 715.07)

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred."). (MPEP 715.07)

4. The only evidence directed to Reduction to practice (as opposed to conception) is the statement in paragraph 5 of the declaration: "The invention described in Exhibit A was conceived and actually reduced to practice by us in the United States at least as early as October 3, 2000."

This is a general assertion of reduction to practice and therefore "'amounts essentially to mere pleading, unsupported by proof or a showing of facts' and, thus, does not satisfy the requirements of 37 CFR 1.131(b)."

Proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose.

5. Applicant relies on the invention disclosure document of October 3, 2000 to establish actual reduction to practice.

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to June 18, 2001 the effective date of the Smith reference.

A written description does not constitute an actual reduction to practice. Furthermore, only the filing of a US patent application which complies with the disclosure requirement of 35 USC § 112 constitutes a constructive reduction to practice. A written description, no matter how complete, which has not been made the subject of a US patent application does not qualify as reduction to practice.

6. Furthermore, the apparatus in question must be commensurate with the CLAIMED invention.

The description of what was allegedly reduced to practice does not support the claimed invention.

While the applicant provides mapping between some features of the claims and Exhibit A, **not all claimed features** are found within the mapping. The applicant relies upon page 2, lines 15-17, page 3, lines 16-21, and Figure 1 to disclose the limitation of

claims 1, 16, 20, 21, 28, 34, and 38. The cited areas fail to specifically disclose "a zoom of the visible element, a callout visibly connected with the visible element, a blurry text version of the visible element, and a perspective text version of the visible element (claim 1, lines 11-14)". The applicant further relies upon page 2, lines 33-37 to recite the limitations of claims 2, 3, 10, 11, 17, 22, and 26. The cited areas fail to specifically disclose, "modifying the appearance of at least one element of a plurality of elements in the reduced-size representation comprises modifying the at least one element that was modified prior to reducing the image (claim 17, lines 1-4)". The applicant relies upon page 2, lines 25-30 to recite the limitations of claims 6, 9, 12, 26, and 27. However, the cited area fails to specifically disclose, "modifying the appearance of the important element (claim 6, lines 3-4)". It further fails to disclose "determining relevance of the first and second elements, the first visible elements being determined to have a higher relevance than the second visible element, wherein modifying the appearance of the at least one element comprises modifying the first visible element with a different modification than the second visible element (claim 12, lines 2-6)". The examples given above are, in no way an admission that the rest of the mappings are proper. The applicant is advised to provide a mapping between all features of the claim and corresponding portions of the exhibit.

For an actual reduction to practice, the invention must have been sufficiently tested to demonstrate that it will work for its intended purpose, but it need not be in a commercially satisfactory stage of development. If a device is so simple, and its purpose and efficacy so obvious, construction alone is sufficient to demonstrate workability. *King Instrument Corp. v. Otari Corp.*, 767 F.2d 853, 860, 226 USPQ 402, 407 (Fed. Cir. 1985).

The applicant claims that testing has been performed (page 3, lines 16-21), but fails to provide evidence of the testing to "demonstrate that it will work for its intended purpose (MPEP 2138.05)."

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3, 6-7, 9-12 and 16-19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Ogden et al. (Document thumbnail visualizations for rapid relevance judgments: When do they pay off?, hereafter Ogden) in further in view of Smith et al. (US 2003/0006995, application 2001, hereafter Smith).

As per independent claim 1, Ogden discloses a method for generating an enhanced thumbnail associated with a document comprising:

- Obtaining a document comprising a plurality of elements (page 1, paragraph 1: Here, document thumbnails are described and the selection of documents is discussed.)
- Generating a reduced-size representation of the document (page 1, paragraph 2: Here, the thumbnail view of documents is discussed with several advantages of the view)

- Modifying an appearance of at least one visible element of the plurality of elements relative to other visible elements of the plurality of elements in the reduced size representation (page 2, Figure 1)

Ogden fails to specifically disclose the method wherein modifying the appearance of the at least one visible element comprises overlaying an overlay element on or near the reduced-size representation in association with the at least one visible element, the overlay element comprising one or more of an enlarged version of the visible element, a zoom of the visible element, a callout visibly connected with the visible element, a blurry text version of the visible element, and a perspective text version of the visible element. However, Smith discloses the method wherein modifying the appearance of the at least one visible element comprises overlaying an overlay element on or near the reduced-size representation in association with the at least one visible element, the overlay element comprising one or more of an enlarged version of the visible element, a zoom of the visible element, a callout visibly connected with the visible element, a blurry text version of the visible element, and a perspective text version of the visible element (Figures 3-4: Here a zoom of a document section is shown).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Ogden's method of generating thumbnails with Smith's method for zooming, since it would have allowed a user to more easily view data stored in a thumbnail image.

As per dependent claim 2 Ogden and Smith discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. Ogden further discloses

method wherein modifying the appearance of the at least one visible element comprises modifying the appearance of the at least one visible element while in a document format (page 2, Figure 1, multiple fish-eye view: Here, some visible elements maintain their original text size and clarity, while other visual element have been blurred).

As per dependent claim 3, Ogden and Smith discloses the limitations similar to those in claim 2, and the same rejection is incorporated herein. Ogden further discloses the method wherein modifying the appearance of the at least one visible element includes modifying at least one of size, color, and font of the at least one visible element relative to other visible elements of the plurality of elements (page 2, Figure 1, multiple fish-eye view: Here, the visible elements have maintained their original size while other visual elements have decreased in font size and been blurred).

As per dependent claim 6, Ogden and Smith discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. Ogden further discloses the method further comprising identifying at least one element of the plurality of elements as an important element, wherein modifying the appearance of at least one visible element comprises modifying the appearance of the important element (page 1, paragraph 3, sentence 2: Here, an area of current interest is used to identify an element; page 2, Figure 1, multiple fish-eye view: Here, the identified element and surrounding elements return to their original size while other areas maintain a smaller size and a blurred text).

As per dependent claim 7, Ogden and Smith discloses the limitations similar to those in claim 6, and the same rejection is incorporated herein. Ogden further discloses

the method wherein modifying the appearance of the important element comprises overlaying a modified version of the important element on or near the reduced size representation (page 2, Figure 1, multiple fish-eye view: Here, the important element returns to its original size in the view while other elements maintain reduced size with blurred text).

As per dependent claim 9, Ogden and Smith discloses the limitations similar to those in claim 6, and the same rejection is incorporated herein. Ogden further discloses the method wherein the important element includes one or more of a header of the document and a keyword input by a user (page 2).

As per dependent claim 10, the applicant discloses the limitations similar to those in claim 2. Claim 10 is similarly rejected under Ogden and Smith.

As per dependent claim 11, the applicant discloses the limitations similar to those in claim 3. Claim 11 is similarly rejected under Ogden and Smith.

As per dependent claim 12, Ogden and Smith discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. Ogden further discloses a method wherein the at least one visible element comprises first and second visible elements, further comprising determining relevance of the first and second elements, the first visible element being determined to have a higher relevance than the second visible element, wherein modifying the appearance of the at least one element comprises modifying the first visible element with a different modification than the second visible element (page 2, Figure 1: Here, several visible elements are shown. In Figure 1 the first visible element is "Research" while the second visible element is

"Laboratory." The first visible element, "Research," is determined to have a higher relevance than the second visible element, "Laboratory," and both are shown with different modification. The first visible element, "Research," is highlighted, while the second visible element, "Laboratory," is merely shown in a font size allowing it to be read).

As per independent claim 16, Ogden discloses a method for generating an enhanced thumbnail of a document comprising:

- Obtaining a document comprising a plurality of elements (page 1, paragraph 1)
- Modifying an appearance of at least one visible element of the plurality of elements in the document (page 2, Figure 1)
- Generating a reduced-size representation associated with the document, in which the modified at least one visible element retains a modified appearance relative to other elements of the document (page 1, paragraph 2)
- Modifying an appearance of at least one of the plurality of elements in the reduced-size representation after generating the reduced-size representation (page 1, paragraph 3, sentence 7: Here, the areas that are returned to a normal sized font are modified after the generating the reduced-size representation)

Ogden fails to specifically disclose the method wherein modifying the appearance of the at least one visible element comprises overlaying an overlay element on or near the reduced-size representation in association with the at least one visible element, the overlay element comprising one or more of an enlarged version of the visible element, a zoom of the visible element, a callout visibly connected with the visible element, a blurry

text version of the visible element, and a perspective text version of the visible element. However, Smith discloses the method wherein modifying the appearance of the at least one visible element comprises overlaying an overlay element on or near the reduced-size representation in association with the at least one visible element, the overlay element comprising one or more of an enlarged version of the visible element, a zoom of the visible element, a callout visibly connected with the visible element, a blurry text version of the visible element, and a perspective text version of the visible element (Figures 3-4: Here a zoom of a document section is shown).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Ogden's method of generating thumbnails with Smith's method for zooming, since it would have allowed a user to more easily view data stored in a thumbnail image.

As per dependent claim 17, Ogden and Smith discloses the limitations similar to those in claim 16, and the same rejection is incorporated herein. Ogden further discloses the method wherein modifying the appearance of at least one element of a plurality of elements in the reduced-size representation comprises modifying the at least one element that was modified prior to reducing the image (page 2, Figure 1).

As per dependent claim 18, Ogden and Smith discloses the limitations similar to those in claim 16, and the same rejection is incorporated herein. Ogden further discloses the method wherein modifying the appearance of at least one element of a plurality of elements in the reduced-size representation comprises modifying an element that was not modified prior to reducing the image (page 1, paragraph 3).

As per dependent claim 19, Ogden and Smith discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. Ogden further discloses the method wherein the reduced-sized representation is a reduced image (page 1, paragraph 1).

9. Claim 13 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Ogden and Smith in further view of Chiou et al. (Perceptual Thumbnail).

As per dependent claim 13, Ogden and Smith disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Ogden fails to specifically disclose the method wherein modifying the appearance of the at least one element comprises modifying an appearance of the reduced-size representation as a whole. However, Chiou discloses the method wherein modifying the appearance of the at least one element comprises modifying an appearance of the reduced-size representation as a whole (page 2, Fig 1; page 3, Text-to-strike substitution).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Ogden and Smith's method for generating enhanced thumbnails with Chiou's method of modifying the appearance of the reduced-size image, since it would have allowed the user to focus on important elements that have been modified to emphasize importance while ignoring less important elements that have been modified so as to not divert a user's attention from important elements.

10. Claims 14 and 15 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Ogden, Smith, and Chiou in further view of Blumberg (US 678309).

As per dependent claim 14 Ogden, Smith, and Chiou disclose the limitations similar to those in claim 13, and the same rejection is incorporated herein. Ogden, Smith, and Chiou fail to disclose the method wherein modifying an appearance of the reduced-size representation as a whole comprises modifying the contrast of the reduced-size representation. However, Blumberg discloses modifying the contrast of image data (column 10, lines 19-26).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Ogden, Smith, and Chiou's method of modifying the appearance of a reduced-size representation with Blumberg's method of modifying the contrast, since it would have allowed a user to have some elements appear sharper than others.

As per dependent claim 15, Ogden, Smith, Chiou, and Blumberg disclose the limitations similar to those in claim 14, and the same rejection is incorporated herein. Blumberg further discloses the method wherein modifying contrast comprises applying a color wash to the reduced-size representation (column 10, lines 19-26).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Ogden, Smith, Chiou, and Blumberg's method of modifying the contrast of a reduced-size representation with Blumberg's method of applying a color wash, since it would have allowed a user to have some elements appear sharper than others.

11. Claim 21-30 and 34-42 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Ogden and Smith in further view of Angiulo et al. (US 6275829, hereafter Angiulo).

As per independent claim 21, the applicant discloses the apparatus for the execution of the method of claim 1. These limitations are similarly rejected under Ogden and Smith. Ogden fails to specifically disclose a renderer that generates a reduced-size representation of the document. However, Angiulo discloses a renderer that generates a reduced-size representation of the document (column 5, lines 26-41).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Ogden and Smith's apparatus for generating an enhanced thumbnail with Angiulo's apparatus for rendering reduced-size representations of documents, since it would have allowed a user to download information more quickly and still have the information of the original document communicated (Angiulo: column 5, lines 38-41).

As per dependent claim 22, Ogden, Smith, and Angiulo disclose the limitations similar to those in claim 21, and the same rejection is incorporated herein. The applicant discloses the apparatus for the execution of the method of claim 3. Claim 22 is similarly rejected under Ogden and Smith in view of Angiulo.

As per dependent claim 25, Ogden, Smith, and Angiulo disclose the limitations similar to those in claim 21, and the same rejection is incorporated herein. The

applicant discloses the apparatus for the execution of the method of claim 6. Claim 25 is similarly rejected under Ogden and Smith in view of Angiulo.

As per dependent claim 26, Ogden, Smith, and Angiulo disclose the limitations similar to those in claim 25, and the same rejection is incorporated herein. The applicant discloses the apparatus for the execution of the method of claim 3. Claim 26 is similarly rejected under Ogden and Smith in view of Angiulo.

As per dependent claim 27 Ogden, Smith, and Angiulo disclose the limitations similar to those in claim 25 and the same rejection is incorporated herein. The applicant discloses the apparatus for the execution of the method of claim 9. Claim 27 is similarly rejected under Ogden and Smith in view of Angiulo.

As per independent claim 28, the applicant discloses the apparatus for the execution of the method of claim 1. These limitations are similarly rejected under Ogden and Smith. Ogden fails to specifically disclose a renderer that generates a reduced-size representation of the document. However, Angiulo discloses a renderer that generates a reduced-size representation of the document (column 5, lines 26-41).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Ogden and Smith's apparatus for generating an enhanced thumbnail with Angiulo's apparatus for rendering reduced-size representations of documents, since it would have allowed a user to download information more quickly and still have the information of the original document communicated (Angiulo: column 5, lines 38-41).

As per dependent claim 34, Ogden, Smith and Angiulo disclose the limitations similar to those in claim 21, and the same rejection is incorporated herein. Ogden further discloses the apparatus including both the document format modifier and the image modifier (page 2, Figure 1).

As per dependent claim 35, Ogden, Smith, and Angiulo disclose the limitations similar to those in claim 34, and the same rejection is incorporated herein. Ogden further discloses the apparatus wherein the at least one visible element modified in the document format and the at least one visible element modified in the reduced-size representation are the same element (page 2, Figure 1).

As per dependent claim 36, Ogden, Smith, and Angiulo disclose the limitations similar to those in claim 34, and the same rejection is incorporated herein. Ogden further discloses the apparatus wherein the at least one visible element modified in the reduced-size representation are different elements (page 2, Figure 1; page 1, paragraph 3: Here, the users can modify the document format by clicking on areas that are not currently areas of interest. The document format would then change to show these areas of interest, while the reduced-sized format would remain the same).

As per dependent claim 37, Ogden, Smith, and Angiulo disclose the limitations similar to those in claim 21, and the same rejection is incorporated herein. Ogden further discloses the apparatus wherein the reduced-size representation is a reduced image (page 4, paragraph 2).

As per dependent claim 39, Ogden, Smith, and Angiulo disclose the limitations similar to those in claim 21, and the same rejection is incorporated herein. Ogden

further discloses the apparatus further comprising a display device (page 1, paragraph 3: Here, in order for the document viewer to work properly, there must be a display device).

As per dependent claim 40, Ogden, Smith, and Angiulo disclose the limitations similar to those in claim 39, and the same rejection is incorporated herein. Ogden further discloses the apparatus wherein the display device is one of a file browser device, an email browser, a hierarchy browser, a system that displays thumbnails of applications of a personal computer, and a handheld device (page 1, paragraph 3).

12. Claim 31 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Ogden, Smith, and Angiulo in further view of Chiou.

As per dependent claim 31, Ogden, Smith, and Angiulo disclose the limitations similar to those in claim 28, and the same rejection is incorporated herein. Ogden and Angiulo fail to disclose the apparatus wherein modifying the appearance of the at least one element comprises modifying an appearance of the reduced-size representation as a whole. However, Chiou discloses the method wherein modifying the appearance of the at least one element comprises modifying an appearance of the reduced-size representation as a whole (page 2, Fig 1; page 3, Text-to-strike substitution).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Ogden and Angiulo's apparatus for generating enhanced thumbnails with Chiou's method of modifying the appearance of the reduced-size image, since it would have allowed the user to focus on important elements that

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have been modified to emphasize importance while ignoring less important elements that have been modified so as to not divert a user's attention from important elements.

13. Claims 32 and 33 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Ogden, Smith, Angiulo, and Chiou in further view of Blumberg.

As per dependent claim 32 Ogden, Smith, Angiulo, and Chiou disclose the limitations similar to those in claim 31, and the same rejection is incorporated herein. Ogden, Smith, Angiulo, and Chiou fail to disclose the method wherein modifying an appearance of the reduced-size representation as a whole comprises modifying the contrast of the reduced-size representation. However, Blumberg discloses modifying the contrast of image data (column 10, lines 19-26).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Ogden, Smith, Angiulo, and Chiou's method of modifying the appearance of a reduced-size representation with Blumberg's method of modifying the contrast, since it would have allowed a user to have some elements appear sharper than others.

As per dependent claim 33, Ogden, Smith, Angiulo, Chiou, and Blumberg disclose the limitations similar to those in claim 32, and the same rejection is incorporated herein. Blumberg further discloses the method wherein modifying contrast comprises applying a color wash to the reduced-size representation (column 10, lines 19-26).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Ogden, Smith, Angiulo, Chiou, and Blumberg's method of modifying the contrast of a reduced-size representation with Blumberg's method of applying a color wash, since it would have allowed a user to have some elements appear sharper than others.

14. Claims 8 and 20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Ogden and Smith in further view of Burke (US 2002/0167534, application 2001)

As per dependent claim 8, Ogden and Smith disclose the limitations similar to those in claim 7, and the same rejection is incorporated herein. Ogden and Smith fail to specifically disclose the method wherein the modified portion is overlaid as a semi-transparent overlay. Burke discloses a semi-transparent overlay (Figures 3-4: Here, an overlay is used to emphasize a frame for reading and attention focusing purposes).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Ogden and Smith's method of modifying the appearance of a document with Burke's method of using an overlay, since it would have allowed a user to make reading of desired portions of text easier (Burke: Abstract).

As per independent claim 20, the applicant discloses the limitations similar to those in claim 1. These limitations are similarly rejected under Ogden and Smith. Ogden and Smith fail to specifically disclose the method wherein the modified portion is overlaid as a semi-transparent overlay. Burke discloses a semi-transparent overlay

(Figures 3-4: Here, an overlay is used to emphasize a frame for reading and attention focusing purposes).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Ogden and Smith's method of modifying the appearance of a document with Burke's method of using an overlay, since it would have allowed a user to make reading of desired portions of text easier (Burke: Abstract).

15. Claims 30 and 38 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Ogden, Smith, and Angiulo in further view of Burke.

As per dependent claim 30, Ogden, Smith, and Angiulo disclose the limitations similar to those in claim 28, and the same rejection is incorporated herein. Ogden, Smith, and Angiulo fail to specifically disclose the method wherein the modified portion is overlaid as a semi-transparent overlay. Burke discloses a semi-transparent overlay (Figures 3-4: Here, an overlay is used to emphasize a frame for reading and attention focusing purposes).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Ogden, Smith, and Angiulo's method of modifying the appearance of a document with Burke's method of using an overlay, since it would have allowed a user to make reading of desired portions of text easier (Burke: Abstract).

As per independent claim 38, the applicant discloses the apparatus similar to the apparatus of claim 21. These limitations are similarly rejected under Ogden, Smith, and

Angiulo. Ogden, Smith, and Angiulo fail to specifically disclose the method wherein the modified portion is overlaid as a semi-transparent overlay. Burke discloses a semi-transparent overlay (Figures 3-4: Here, an overlay is used to emphasize a frame for reading and attention focusing purposes).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Ogden, Smith, and Angiulo's method of modifying the appearance of a document with Burke's method of using an overlay, since it would have allowed a user to make reading of desired portions of text easier (Burke: Abstract).

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Hoffman et al. (US 5250929, patented 5 October 1993): Discloses an interactive overlay computer display system.
- Berson et al. (US 6321648, patented 27 November 2001): Discloses document tagging.
- Ubillos (US 5999173, patented 7 December 1999): Discloses video editing along a timeline.
- Hecht (US 5901224, patented 4 May 1999): Discloses embedded data for copyright management and distribution control.
- Daniele (US 5444779, patented 22 August 1995): Discloses electronic copyright royalty accounting using glyphs.

17. This is a continuation of applicant's earlier Application No. 09/682229. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle R. Stork whose telephone number is (571) 272-4130. The examiner can normally be reached on Monday-Friday (8:00-4:30).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kyle Stork
Patent Examiner
Art Unit 2178

hrs



CESAR PAULA
PRIMARY EXAMINER